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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,558	02/25/2002	Kevin Scott Smith	UNCC#2001-001/46872.26008	3190
7590	06/28/2005		EXAMINER	
John C. Alemanni Kilpatrick Stockton LLP 1001 West Fourth Street Winston-Salem, NC 27101-2410			RAO, SHEELA S	
		ART UNIT	PAPER NUMBER	2125

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/082,558	SMITH ET AL.	
	Examiner	Art Unit	
	Sheela Rao	2125	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 April 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-20 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment and remarks filed on April 11, 2005 has been entered and considered.
2. Claims 1-20 are pending and presented for examination. Claims 1, 11 12, and 15-17 have been amended.

Response to Amendment

3. The objection to the title is **withdrawn** in light of the changes made to the same.
4. Examiner apologizes for the error in stating the rejection of claims 1-5 and 9-20 under 35 USC § 102(b). The rejection under 102(b) was a typographical oversight, the rejection should have been made under the rules of 35 USC § 102(e). Examiner regrets having caused any inconveniences and apologizes for such.
5. Claims 1-5 and 9-20 are rejected under 35 USC §102(e) as being anticipated by Thackston, US Patent No. 6,295,513. The rejection is **maintained** and restated below.
6. The rejection of claims 6-8 under 35 USC § 103(a) as being unpatentable over Thackston is **maintained** and restated below.

Claim Rejections

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-5 and 9-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Thackston, US Patent No. 6,295,513.

The invention by Thackston relates to a computer-based system and method for the design and development of an idea in a virtual collaborative environment. In doing so, the steps of defining product specifications, system specifications, identifying qualified fabricators for manufacturing the part design, and accepting bids from qualified manufacturers are followed.

As per the limitations of the instant invention, with reference to Figure 16 the patented disclosure provides an overview of the method used in undertaking the design and development of a project. See Figures 16A and 16B along with the description given beginning at column 27: line 58.

To be more specific, the reference of prior art teaches the "specifying a requirement for a part to be produced", as in claim 1 of the instant invention, in the design and development phase referred to as NICECAD, see column 8: line 58, et seq. in relation to Figure 2, and column 13: ll. 43-67. The limitations directed to "generating a recipe for production of [the] part conforming to said requirement", as per claims 1, 5, 9, and 10 of the instant invention, is taught by the Thackston reference with the use of a Product Data Manager (PDM) which stores data for individual projects. The stored data includes technical data, contractual information, as well as budget and schedule information. The PDM is a part of the NICECAD development and design phase. See column 14: ll. 6-30 and Figure 8. As per the limitations of "identifying a vendor capable of producing said part ..." (instant claims 1-3, and 11-14), the NICECAD system comprises a Global Manufacturer's Registry (GMR) which is used for the identification and evaluation of qualified/certified fabricators or manufacturers for a design. See column 5: ll. 30-54. In addition to the vendor data being stored in the database (instant claim 13), standards and specifications with regard to the manufacturing, inspection and fabrication (instant claim 20) are also included. See column 16: ll. 34-67. The aspect of monitoring the manufacturing/production of the part using some type of communication (as in instant claims 4 and 15-17) is taught by the "check-in/check-out module" of the NICECAD system as detailed in column 14: line 42, et seq.

Furthermore, the NICECAD system and method consists of an Electronic Trading Community (ETC) that manages the negotiations of vendors bidding to manufacture the parts/products (as in instant claims 18 and 19). See column 5: line 55, et seq.

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Thackston, US Patent No. 6,295,513.

Thackston teaches the limitations of the instant invention as applied to claims 1-5 as stated above. However, the disclosure of the invention by Thackston fails to teach or fairly suggest the particular use of a plurality of machines and one tool to produce a part, or one machine and a plurality of tools to produce a part, or a plurality of machines and a plurality of tools to produce one part, or any combination thereof. Although, the NICECAD system and method of the patented invention does include several databases which contain information about a variety of aspects of the manufacturing/production system, the use of "plural" machines/tools in any combination has not been specifically detailed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a machine/tool selection component within the NICECAD system to have a selection/designation segment for identifying the number of machines or tools used to produce a part. The use of a plurality of devices would allow for greater efficiency and more economic gain; which would in turn benefit all parties.

11. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thackston, US Patent No. 6,295,513 B1 in view of Kakazu et al., US Patent No. 5,388,199.

The limitations of the claimed invention as taught by Thackston is stated above. With regard to the newly added limitation of claim 1 wherein the identification of an optimal machine and tooling combination for producing a part is claimed, Thackston teaches the selection of fabricators for manufacturing part design through the identification of qualified fabricators based on information stored in a global database, see abstract and col. 5: ll. 30-54. However, Thackston does not specifically disclose

the identifying of an "optimal" combination, for this reason the patented invention to Kakazu et al. (hereinafter, "Kakazu") is relied upon. Kakazu discloses a machine tool determining module that chooses the optimal machine tool from a machine tool registry or master file. Furthermore, the module has the capability to select machines out of the file based on the data of the workpiece. See col. 9: II.58, et seq. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the machine tool module comprising a master file as used by Kakazu for determining optimal machines and tools in the computer-based design and development system as taught by Thackston for the benefit of a more efficient and functional production of a part.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1, 2, 6, 7, 9, 11, 12, 18, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Upon further review and consideration, in view of the amendments made to the instant claim language, the following issues of indefiniteness arise.

Claim 1 – the newly added limitation of "identifying an optimal machine and tooling combination for production of said part" bares no support in the claim language. Due to the lack of adequate association, the use and purpose of the claimed limitation is not clear and definite. Furthermore, a statement of desired result where a limitation has no support within the claim language itself is not proper and is indefinite.

Claim 2 – "creating a vendor" is stated in the claim; how a vendor is "created" is not clear since a vendor is not an entity that can be made or produced.

Claims 6, 7, 9, 11, and 12 – all use the term "effective" as a term of degree in establishing a combination of machines and tools. When a term of degree is used as a limitation, it is necessary to

determine whether the specification provides some standard for measuring that degree. See *Seattle Box Company, Inc. V. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984). In this case, the specification does not enable one skilled in the art to reasonably establish what may be construed as being within the metes and bounds of the word of degree. Therefore, one of ordinary skill in the art would not be apprised as to the claimed invention's scope when the claims are read in light of the specification. See *Ex parte Oetiker*, 23 USPQ2d 1641.

Claims 18 and 19 – cite the limitation of “said executing said recipe” which lacks antecedence, claim 18 depends from claim 1 and claim 19 from claim 7; neither claims 1 or 7 assert the execution of a recipe.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

14. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

15. Claims 1-15 and 18-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. In this case, no such concrete, tangible and useful result has been claimed.

Response to Arguments

16. With regard to Applicant's statement about the date of the Thackston reference and improper citation of the statue, Examiner acknowledges the oversight made in citing the statement of statutory basis, and has corrected the statement as stated above.

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17. Applicant's arguments, filed April 11, 2005, with respect to the limitations of claim 1, have been fully considered and are somewhat persuasive. Applicant argues that the reference of prior art to Thackston does not anticipate the "identifying an optimal machine and tooling combination for production of said part" as newly added to instant claim 1. Examiner disagrees as aforementioned as Thackston does indeed foresee the need to identify fabricators for producing a part. But to overcome any deficiencies, Examiner cites the reference of prior art to Kakazu where an OPTIMAL machine and tool are associated one with the other for production of a part.

Upon further examination of the instant application in light of the amendments made to the instant claims, Examiner recognized additional issues in the claim language. Thus, these matters have been addressed as stated above.

Claims 1-20 remain pending and rejected for the reasons stated above; therefore, claims 1-20 are not novel or unobvious and are unpatentable.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sebastian et al. USPN Re. 36,602

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2125

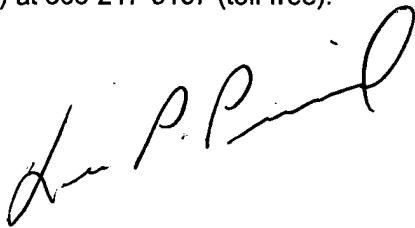
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela Rao whose telephone number is (571) 272-3751. The examiner can normally be reached Monday - Friday from 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard, can be reached on (571) 272-3749. The fax number for the organization where this application or any proceeding papers is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. It should be noted that status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should any questions arise regarding access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sheela S. Rao
June 16, 2005



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